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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,818	06/25/2003	Vidhu J. Nagpal	1778A1	9488

7590 07/17/2006

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Law-Intellectual Property-39SW
One PPG Place
Pittsburgh, PA 15272

EXAMINER

KOPEC, MARK T

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/602,818	Applicant(s) NAGPAL ET AL.	
	Examiner Mark Kopec	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-21, 25, 26, 31-35, 37, 39-53 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 16-21, 31-35, 37, 39, 46, 47 and 55-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-14, 25, 26, 40-45 and 48-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This action is responsive to applicant's amendment/remarks filed 04/27/06. Claims 1-14, 16-21, 25, 26, 31-35, 37, 39-53 and 55-60 are currently pending with claims 7, 8, 16-21, 31-35, 37, 39, 46, 47 and 55-60 withdrawn from consideration.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 9-14, 25, 26, 40-45 and 48-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the examiner fails to find support for the instant claims language "A **non-photochromic** optical article...".

Applicant's remarks regarding this language are noted. The examiner agrees that the instant specification teaches "The polymerizable composition of the present invention can be used to produce a photochromic article" (page 33 of specification). However, the examiner submits that such does not show possession

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(at the time the invention was filed) for the instant limitation "A **non-photochromic** optical article...". Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) and *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. 132 or 251 as appropriate, and require applicant to cancel the new matter. If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. In *re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). The examiner should

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still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant.

The prior art rejection over Schmidt et al (5,910,522) is withdrawn in view of applicant's amendment/remarks.

Specifically, Schmidt et al (5,910,522) does not disclose or suggest the instantly claimed Markush group of non-photochromic optical articles.

The prior art rejection over Arney et al (6,432,526) is withdrawn in view of applicant's amendment/remarks.

Specifically, Arney et al (6,432,526) does not disclose or suggest the instantly claimed species of polymerizable polyol(allyl carbonate) monomer.

Claims 1-6, 9-14, 25, 26, 40-45 and 48-53 are rejected under 35 U.S.C. 103(a) as obvious over Selvig et al (5,236,978).

This rejection is maintained for the reasons set forth in the Rejection mailed 01/26/06 (pages 4-6).

Applicant's remarks regarding this rejection are noted. Specifically, applicant argues that Selvig does not disclose or suggest the instantly claimed "non-photochromic optical articles".

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The examiner respectfully submits that Selvig teaches optical articles which may or may not be photochromic. For example, at Col 9, lines 15-24, Selvig states:

Various additives may be incorporated with the polymerizable polyol(allyl carbonate) composition. Such additives may include light stabilizer, heat stabilizers and ultraviolet light absorbers. In addition, it is contemplated that a form of photochromic substance resistant to the effects of the peroxy-type initiator **may also be added** to the polymerizable resin composition. Such photochromic substances include photochromic pigments and photochromic compounds encapsulated in metal oxides, the latter of which is such as described in U.S. Pat. No. 4,166,043 and 4,367,170 (emphasis added)

The examiner respectfully submits that such a teaching renders obvious the claimed Markush group of "**non-photochromic** optical articles".

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mark Kopec
Primary Examiner
Art Unit 1751

MK

July 10, 2006